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Andreas Eipper

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EXAMINER

LEE, DORIS L

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/587,997	<b>Applicant(s)</b> EIPPER ET AL.	
	<b>Examiner</b> Doris L. Lee	<b>Art Unit</b> 1796	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 05 April 2010.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                    | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)         | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. **Claims 1-14** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Gareiss et al (US 6,084,012)** in view of **Davis et al (GB 2 324 797)**

**Regarding claims 1 and 11-12**, Gareiss teaches a thermoplastic composition (Abstract) comprising:

- A) 5 to 99 % by weight of at least one thermoplastic polyester (Abstract)
- C) 0 to 70 % by weight of other additives and processing aids.

However, Gareiss fails to teach the addition of

B) from 0.01 to 50% by weight of a mixture a highly branched or hyperbranched polycarbonate with an OH number of from 1 to 600 mg, further from 10 to 550 and further from 50 to 550 KOH/g of polycarbonate (to DIN 53240, part 2), or

Davis teaches generally, hyperbranched polymers, one of which can be hyperbranched polycarbonate (Abstract) with both structural and molecular non-uniformity (Page 1, lines 15-30).

It would have been obvious to one of ordinary skill in the art at the time of the invention to add the hyperbranched polycarbonate of Davis to the composition of Gareiss. One would have been motivated to do so in order to receive the expected

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benefit of controlling the processability of the thermoplastic polyester by behaving like a reactive plasticizer (Davis, page 16, last paragraph). They are combinable because they are concerned with the same field of endeavor, namely additives of thermoplastics. Absent objective evidence to the contrary and based upon the teachings of the prior art, there would have been a reasonable expectation of success.

As to the amount of the hyperbranched polymers and the OH number of the polycarbonate, it is the examiner's position that the amounts are result effective variables because changing them will clearly affect the type of product obtained. See MPEP § 2144.05 (B). Case law holds that "discovery of an optimum value of a result effective variable in a known process is ordinarily within the skill of the art." See *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

In view of this, it would have been obvious to one of ordinary skill in the art to utilize appropriate amounts of hyperbranched polyester or highly branched polycarbonate to achieve the desired processability of the flame retarded thermoplastic, including those within the scope of the present claims, so as to produce desired end results.

**Regarding claim 2**, modified Gareiss teaches that the molecular weight of the hyperbranched polycarbonate is 5,000 (Davis, page 20, Example 5).

**Regarding claims 3-4**, modified Gareiss fails to explicitly teach the glass transition temperature and the viscosity of the hyperbranched polyester, however, it does disclose a hyperbranched polycarbonate that meets the claimed limitations, it is therefore inherent that the hyperbranched polycarbonate of modified Gareiss has such

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properties as presently claimed since such a property is evidently dependent upon the nature of the composition used. Case law holds that a material and its properties are inseparable. In re Spada, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990).

**Regarding claims 5-8**, as these are product-by-process claims, patentability of said claim is based on the recited product and does not depend on its method of production. Since the product claimed is the same as product disclosed by Davis the claim is unpatentable even though the Davis product was made by a different process. In re Marosi, 710 F.2d 798, 802, 218 USPQ 289, 292 (Fed. Cir. 1983). See MPEP 2113.

**Regarding claims 9 and 10**, modified Gareiss teaches that a fiber, foil, or molding can be made (Gareiss, col. 13, lines 1-10) via conventional apparatus to form shaped articles (Gareiss, col. 13, lines 1-10).

**Regarding claims 13-14**, modified Gareiss teaches that hyperbranched polymers are made (Davis, page 1, first paragraph) and further teaches that only when the degree of branching is greater than 40%, is a dendritic polymer considered to be a hyperbranched polymer (Davis, page 2, lines 13-18).

It is well settled that where the prior art describes the components of a claimed compound or compositions in concentrations within or overlapping the claimed concentrations a prima facie case of obviousness is established. See In re Harris, 409 F.3d 1339, 1343, 74 USPQ2d 1951, 1953 (Fed. Cir 2005); In re Peterson, 315 F.3d 1325, 1329, 65 USPQ 2d 1379, 1382 (Fed. Cir. 1997); In re Woodruff, 919 F.2d 1575, 1578 16 USPQ2d 1934, 1936-37 (CCPA 1990); In re Malagari, 499 F.2d 1297, 1303, 182 USPQ 549, 553 (CCPA 1974).

### ***Double Patenting***

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

### **Double Patenting 1**

4. **Claims 1-14** are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over **1 and 12-13** of copending **Application No. 10/587,998** in view of **Davis (GB 2,324,797)**.

The claims of Application '998 teach a thermoplastic molding composition comprising a thermoplastic polyester, a hyperbranched polyester and other conventional additives.

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However, the claims of Application '998 do not teach the addition of hyperbranched polycarbonate.

Davis teaches a hyperbranched polycarbonate (Abstract) which can be used as a reactive plasticizer for thermoplastic materials (Davis, page 16, last paragraph).

It would have been obvious to a person of ordinary skill in the art at the time of the invention to use the hyperbranched polycarbonate of Davis in the composition recited in the claims of Application '998. One would have been motivated to do so in order to receive the expected benefit of improving the processability by utilizing a reactive plasticizer (Davis, page 16, last paragraph). They are combinable because they are both concerned with the same field of endeavor, namely thermoplastic resins. Absent objective evidence to the contrary and based upon the teachings of the prior art, there is a reasonable expectation of success.

This is a provisional obviousness-type double patenting rejection.

### **Double Patenting 2**

5. **Claims 1-14** are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over **claims 1-10 and 13-21** of copending **Application No. 11/576,646**. Although the conflicting claims are not identical, they are not patentably distinct from each other because they both recite a thermoplastic material with a, hyperbranched polycarbonate and other conventional additives. Although it is noted that the copending application contains additional ingredient(s) not explicitly present in the instant claims, nevertheless, given that both sets of claims are recited in open language (cf. comprising) so that the present claims

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are open to the inclusion of additional unrecited ingredients, the overlap in scope supports and warrants the instant rejection.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

6. **Claims 1-14** are directed to an invention not patentably distinct from **claims 1-10 and 13-21** of commonly assigned **Application No. 11/576,646**. Specifically, see the discussion in paragraph 5 above.

The U.S. Patent and Trademark Office normally will not institute an interference between applications or a patent and an application of common ownership (see MPEP Chapter 2300). Commonly assigned **Application 11/576,646**, discussed above, would form the basis for a rejection of the noted claims under 35 U.S.C. 103(a) if the commonly assigned case qualifies as prior art under 35 U.S.C. 102(e), (f) or (g) and the conflicting inventions were not commonly owned at the time the invention in this application was made. In order for the examiner to resolve this issue, the assignee can, under 35 U.S.C. 103(c) and 37 CFR 1.78(c), either show that the conflicting inventions were commonly owned at the time the invention in this application was made, or name the prior inventor of the conflicting subject matter.

A showing that the inventions were commonly owned at the time the invention in this application was made will preclude a rejection under 35 U.S.C. 103(a) based upon the commonly assigned case as a reference under 35 U.S.C. 102(f) or (g), or 35 U.S.C. 102(e) for applications pending on or after December 10, 2004.

**Double Patenting 3**



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7. **Claims 1-14** are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over **claims 1-10 and 15-21** of copending **Application No. 11/577,009**. Although the conflicting claims are not identical, they are not patentably distinct from each other because they both recite a thermoplastic material with a hyperbranched polycarbonate and other conventional additives. Although it is noted that the copending application contains additional ingredient(s) not explicitly present in the instant claims, nevertheless, given that both sets of claims are recited in open language (cf. comprising) so that the present claims are open to the inclusion of additional unrecited ingredients, the overlap in scope supports and warrants the instant rejection.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

8. **Claims 1-14** are directed to an invention not patentably distinct from **claims 1-10 and 15-21** of commonly assigned **Application No. 11/577,009**. Specifically, see the discussion in paragraph 7 above.

The U.S. Patent and Trademark Office normally will not institute an interference between applications or a patent and an application of common ownership (see MPEP Chapter 2300). Commonly assigned **Application No. 11/577,009**, discussed above, would form the basis for a rejection of the noted claims under 35 U.S.C. 103(a) if the commonly assigned case qualifies as prior art under 35 U.S.C. 102(e), (f) or (g) and the conflicting inventions were not commonly owned at the time the invention in this application was made. In order for the examiner to resolve this issue, the assignee can,

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under 35 U.S.C. 103(c) and 37 CFR 1.78(c), either show that the conflicting inventions were commonly owned at the time the invention in this application was made, or name the prior inventor of the conflicting subject matter.

A showing that the inventions were commonly owned at the time the invention in this application was made will preclude a rejection under 35 U.S.C. 103(a) based upon the commonly assigned case as a reference under 35 U.S.C. 102(f) or (g), or 35 U.S.C. 102(e) for applications pending on or after December 10, 2004.

**Double Patenting 4**

9. **Claims 1-14** are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over **claims 1-20** of copending **Application No. 11/577,587**.

The claims of Application '587 recite a thermoplastic material with, hyperbranched polycarbonate and other conventional additives. Although it is noted that the copending application contains additional ingredient(s) not explicitly present in the instant claims, nevertheless, given that both sets of claims are recited in open language (cf. comprising) so that the present claims are open to the inclusion of additional unrecited ingredients, the overlap in scope supports and warrants the instant rejection.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

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10. **Claims 1-14** are directed to an invention not patentably distinct from **claims 1-20** of commonly assigned **Application No. 11/577,587**. Specifically, see the discussion in paragraph 9 above.

The U.S. Patent and Trademark Office normally will not institute an interference between applications or a patent and an application of common ownership (see MPEP Chapter 2300). Commonly assigned **Application No. 11/577,587**, discussed above, would form the basis for a rejection of the noted claims under 35 U.S.C. 103(a) if the commonly assigned case qualifies as prior art under 35 U.S.C. 102(e), (f) or (g) and the conflicting inventions were not commonly owned at the time the invention in this application was made. In order for the examiner to resolve this issue, the assignee can, under 35 U.S.C. 103(c) and 37 CFR 1.78(c), either show that the conflicting inventions were commonly owned at the time the invention in this application was made, or name the prior inventor of the conflicting subject matter.

A showing that the inventions were commonly owned at the time the invention in this application was made will preclude a rejection under 35 U.S.C. 103(a) based upon the commonly assigned case as a reference under 35 U.S.C. 102(f) or (g), or 35 U.S.C. 102(e) for applications pending on or after December 10, 2004.

**Double Patenting 5**

11. **Claims 1-14** are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over **claims 1-21** of copending **Application No. 11/577,590**.

The claims of Application '590 recite thermoplastic material with a hyperbranched polycarbonate and other conventional additives. Although it is noted that the copending application contains additional ingredient(s) not explicitly present in the instant claims, nevertheless, given that both sets of claims are recited in open language (cf. comprising) so that the present claims are open to the inclusion of additional unrecited ingredients, the overlap in scope supports and warrants the instant rejection.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

12. **Claims 1-14** are directed to an invention not patentably distinct from **claims 1-21** of commonly assigned **Application No. 11/577,590**. Specifically, see the discussion as discussed in paragraph 11 above.

The U.S. Patent and Trademark Office normally will not institute an interference between applications or a patent and an application of common ownership (see MPEP Chapter 2300). Commonly assigned **Application No. 11/577,590**, discussed above, would form the basis for a rejection of the noted claims under 35 U.S.C. 103(a) if the commonly assigned case qualifies as prior art under 35 U.S.C. 102(e), (f) or (g) and the conflicting inventions were not commonly owned at the time the invention in this application was made. In order for the examiner to resolve this issue, the assignee can, under 35 U.S.C. 103(c) and 37 CFR 1.78(c), either show that the conflicting inventions were commonly owned at the time the invention in this application was made, or name the prior inventor of the conflicting subject matter.

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A showing that the inventions were commonly owned at the time the invention in this application was made will preclude a rejection under 35 U.S.C. 103(a) based upon the commonly assigned case as a reference under 35 U.S.C. 102(f) or (g), or 35 U.S.C. 102(e) for applications pending on or after December 10, 2004.

**Double Patenting 6**

13. **Claims 1-14** are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over **1-20** of copending **Application No. 11/632,711**.

The claims of Application '711 teach a thermoplastic molding composition comprising a thermoplastic polyester, a hyperbranched polycarbonate and other conventional additives. Although it is noted that the copending application contains additional ingredient(s) not explicitly present in the instant claims, nevertheless, given that both sets of claims are recited in open language (cf. comprising) so that the present claims are open to the inclusion of additional unrecited ingredients, the overlap in scope supports and warrants the instant rejection.

This is a provisional obviousness-type double patenting rejection.

14. **Claims 1-14** are directed to an invention not patentably distinct from claim **claims 1-20** of commonly assigned **Application No. 11/623,711**. Specifically, see the discussion in paragraph 13 above.

The U.S. Patent and Trademark Office normally will not institute an interference between applications or a patent and an application of common ownership (see MPEP Chapter 2300). Commonly assigned Application No. 11/623,711, discussed above,

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would form the basis for a rejection of the noted claims under 35 U.S.C. 103(a) if the commonly assigned case qualifies as prior art under 35 U.S.C. 102(e), (f) or (g) and the conflicting inventions were not commonly owned at the time the invention in this application was made. In order for the examiner to resolve this issue, the assignee can, under 35 U.S.C. 103(c) and 37 CFR 1.78(c), either show that the conflicting inventions were commonly owned at the time the invention in this application was made, or name the prior inventor of the conflicting subject matter.

A showing that the inventions were commonly owned at the time the invention in this application was made will preclude a rejection under 35 U.S.C. 103(a) based upon the commonly assigned case as a reference under 35 U.S.C. 102(f) or (g), or 35 U.S.C. 102(e) for applications pending on or after December 10, 2004.

**Double Patenting 7**

15. **Claims 1-14** are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over **claims 1-20** of copending **Application No. 11/659,506**.

The claims of Application '506 recite a thermoplastic material with a hyperbranched polycarbonate and other conventional additives. Although it is noted that the copending application contains additional ingredient(s) not explicitly present in the instant claims, nevertheless, given that both sets of claims are recited in open language (cf. comprising) so that the present claims are open to the inclusion of additional unrecited ingredients, the overlap in scope supports and warrants the instant rejection.

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This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

16. **Claims 1-14** are directed to an invention not patentably distinct from **claims 1-20** of commonly assigned **Application No. 11/659,506**. Specifically, see the discussion in paragraph 15 above.

The U.S. Patent and Trademark Office normally will not institute an interference between applications or a patent and an application of common ownership (see MPEP Chapter 2300). Commonly assigned **Application 11/659,506**, discussed above, would form the basis for a rejection of the noted claims under 35 U.S.C. 103(a) if the commonly assigned case qualifies as prior art under 35 U.S.C. 102(e), (f) or (g) and the conflicting inventions were not commonly owned at the time the invention in this application was made. In order for the examiner to resolve this issue, the assignee can, under 35 U.S.C. 103(c) and 37 CFR 1.78(c), either show that the conflicting inventions were commonly owned at the time the invention in this application was made, or name the prior inventor of the conflicting subject matter.

A showing that the inventions were commonly owned at the time the invention in this application was made will preclude a rejection under 35 U.S.C. 103(a) based upon the commonly assigned case as a reference under 35 U.S.C. 102(f) or (g), or 35 U.S.C. 102(e) for applications pending on or after December 10, 2004.

**Double Patenting 8**

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17. **Claims 1-14** are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over **claims 1-13** of copending **Application No. 11/659,625**.

The claims of Application '625 recite thermoplastic material with a hyperbranched polycarbonate and other conventional additives. Although it is noted that the copending application contains additional ingredient(s) not explicitly present in the instant claims, nevertheless, given that both sets of claims are recited in open language (cf. comprising) so that the present claims are open to the inclusion of additional unrecited ingredients, the overlap in scope supports and warrants the instant rejection.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

18. **Claims 1-14** are directed to an invention not patentably distinct from **claims 1-13** of commonly assigned **Application No. 11/659,625**. Specifically, see the discussion in paragraph 17 above.

The U.S. Patent and Trademark Office normally will not institute an interference between applications or a patent and an application of common ownership (see MPEP Chapter 2300). Commonly assigned Application 11/659,625, discussed above, would form the basis for a rejection of the noted claims under 35 U.S.C. 103(a) if the commonly assigned case qualifies as prior art under 35 U.S.C. 102(e), (f) or (g) and the conflicting inventions were not commonly owned at the time the invention in this application was made. In order for the examiner to resolve this issue, the assignee can, under 35 U.S.C. 103(c) and 37 CFR 1.78(c), either show that the conflicting inventions



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were commonly owned at the time the invention in this application was made, or name the prior inventor of the conflicting subject matter.

A showing that the inventions were commonly owned at the time the invention in this application was made will preclude a rejection under 35 U.S.C. 103(a) based upon the commonly assigned case as a reference under 35 U.S.C. 102(f) or (g), or 35 U.S.C. 102(e) for applications pending on or after December 10, 2004.

**Double Patenting 9**

19. **Claims 1-14** are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over **claims 14-25** of copending **Application No. 11/813,638**.

The claims of Application '638 recite a polymer with a hyperbranched polycarbonate and other conventional additives.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

20. **Claims 1-14** are directed to an invention not patentably distinct from **claims 14-25** of commonly assigned **Application No. 11/813,638**. Specifically, see the discussion in paragraph 19 above.

The U.S. Patent and Trademark Office normally will not institute an interference between applications or a patent and an application of common ownership (see MPEP Chapter 2300). Commonly assigned **Application No. 11/813,638**, discussed above, would form the basis for a rejection of the noted claims under 35 U.S.C. 103(a) if the commonly assigned case qualifies as prior art under 35 U.S.C. 102(e), (f) or (g) and the

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conflicting inventions were not commonly owned at the time the invention in this application was made. In order for the examiner to resolve this issue, the assignee can, under 35 U.S.C. 103(c) and 37 CFR 1.78(c), either show that the conflicting inventions were commonly owned at the time the invention in this application was made, or name the prior inventor of the conflicting subject matter.

A showing that the inventions were commonly owned at the time the invention in this application was made will preclude a rejection under 35 U.S.C. 103(a) based upon the commonly assigned case as a reference under 35 U.S.C. 102(f) or (g), or 35 U.S.C. 102(e) for applications pending on or after December 10, 2004.

**Double Patenting 10**

21. **Claims 1-14** are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over **claims 14-25** of copending **Application No. 11/813,833**.

The claims of Application '833 recite a polymer with, a hyperbranched polycarbonate and other conventional additives.

Although it is noted that the copending application contains additional ingredient(s) not explicitly present in the instant claims, nevertheless, given that both sets of claims are recited in open language (cf. comprising) so that the present claims are open to the inclusion of additional unrecited ingredients, the overlap in scope supports and warrants the instant rejection.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

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22. **Claims 1-14** are directed to an invention not patentably distinct from **claims 14-25** of commonly assigned **Application No. 11/813,833**. Specifically, see the discussion in paragraph 21 above.

The U.S. Patent and Trademark Office normally will not institute an interference between applications or a patent and an application of common ownership (see MPEP Chapter 2300). Commonly assigned Application No. 11/813,833, discussed above, would form the basis for a rejection of the noted claims under 35 U.S.C. 103(a) if the commonly assigned case qualifies as prior art under 35 U.S.C. 102(e), (f) or (g) and the conflicting inventions were not commonly owned at the time the invention in this application was made. In order for the examiner to resolve this issue, the assignee can, under 35 U.S.C. 103(c) and 37 CFR 1.78(c), either show that the conflicting inventions were commonly owned at the time the invention in this application was made, or name the prior inventor of the conflicting subject matter.

A showing that the inventions were commonly owned at the time the invention in this application was made will preclude a rejection under 35 U.S.C. 103(a) based upon the commonly assigned case as a reference under 35 U.S.C. 102(f) or (g), or 35 U.S.C. 102(e) for applications pending on or after December 10, 2004.

**Double Patenting 11**

23. **Claims 1-14** are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over **claims 1-20** of copending **Application No. 11/996,489**.

The claims of Application '489 recite a polymer with, a hyperbranched polycarbonate and other conventional additives.

Although it is noted that the copending application contains additional ingredient(s) not explicitly present in the instant claims, nevertheless, given that both sets of claims are recited in open language (cf. comprising) so that the present claims are open to the inclusion of additional unrecited ingredients, the overlap in scope supports and warrants the instant rejection.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

24. **Claims 1-14** are directed to an invention not patentably distinct from **claims 1-20** of commonly assigned **Application No. 11/996,489**. Specifically, see the discussion in paragraph 23 above.

The U.S. Patent and Trademark Office normally will not institute an interference between applications or a patent and an application of common ownership (see MPEP Chapter 2300). Commonly assigned Application No. 11/996,489, discussed above, would form the basis for a rejection of the noted claims under 35 U.S.C. 103(a) if the commonly assigned case qualifies as prior art under 35 U.S.C. 102(e), (f) or (g) and the conflicting inventions were not commonly owned at the time the invention in this application was made. In order for the examiner to resolve this issue, the assignee can, under 35 U.S.C. 103(c) and 37 CFR 1.78(c), either show that the conflicting inventions were commonly owned at the time the invention in this application was made, or name the prior inventor of the conflicting subject matter.

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A showing that the inventions were commonly owned at the time the invention in this application was made will preclude a rejection under 35 U.S.C. 103(a) based upon the commonly assigned case as a reference under 35 U.S.C. 102(f) or (g), or 35 U.S.C. 102(e) for applications pending on or after December 10, 2004.

**Double Patenting 12**

25. **Claims 1-14** are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over **claims 1-20** of copending **Application No. 11/815,238**.

The claims of Application '238 recite a polymer with a hyperbranched polycarbonate and other conventional additives.

Although it is noted that the copending application contains additional ingredient(s) not explicitly present in the instant claims, nevertheless, given that both sets of claims are recited in open language (cf. comprising) so that the present claims are open to the inclusion of additional unrecited ingredients, the overlap in scope supports and warrants the instant rejection.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

26. **Claims 1-14** are directed to an invention not patentably distinct from **claims 1-20** of commonly assigned **Application No. 11/815,238**. Specifically, see the discussion in paragraph 25 above.

The U.S. Patent and Trademark Office normally will not institute an interference between applications or a patent and an application of common ownership (see MPEP

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Chapter 2300). Commonly assigned Application No. 11/815,238, discussed above, would form the basis for a rejection of the noted claims under 35 U.S.C. 103(a) if the commonly assigned case qualifies as prior art under 35 U.S.C. 102(e), (f) or (g) and the conflicting inventions were not commonly owned at the time the invention in this application was made. In order for the examiner to resolve this issue, the assignee can, under 35 U.S.C. 103(c) and 37 CFR 1.78(c), either show that the conflicting inventions were commonly owned at the time the invention in this application was made, or name the prior inventor of the conflicting subject matter.

A showing that the inventions were commonly owned at the time the invention in this application was made will preclude a rejection under 35 U.S.C. 103(a) based upon the commonly assigned case as a reference under 35 U.S.C. 102(f) or (g), or 35 U.S.C. 102(e) for applications pending on or after December 10, 2004.

### ***Response to Arguments***

27. The objections to claim 11 and 12 set forth in paragraph 3 of the Office Action mailed on August 6, 2009 has been withdrawn in light of applicant's amendment filed on March 5, 2010.

28. Applicant's arguments filed March 5, 2010 have been fully considered but they are not persuasive for the reasons set forth below:

29. **Applicant's argument:** Gareiss, when compared to the presently claimed invention, there is no provision of a thermoplastic polyester molding composition with the highly branched or polycarbonates, or any indication that highly branched or hyperbranched polycarbonates are obtainable by a low-cost simple industrial process.

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**Examiner's response:** *Gareiss is open to the addition of additives as noted in the above rejection. The examiner acknowledges that Gareiss does not teach the addition of the hyperbranched or highly branched polycarbonates, however, that teaching is provided by the secondary reference, Davis. The examiner has provided adequate motivation to combine the references, the rejection set forth above is maintained.*

30. **Applicant's argument:** Other than hindsight of the present specification, there is no indication or expectation of achieving a composition having the combined good flowability and mechanical properties of the claimed invention.

**Examiner's response:** *In response to applicant's argument that the prior art references do not mention the improved flowability and mechanical properties of the claimed invention, the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See Ex parte Obiaya, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).*

31. **Applicant's argument:** Regarding Davis, the polycarbonates described in the reference are entirely different from and clearly unobvious over the claimed invention.

**Examiner's response:** *As the applicant has failed to specifically point out the differences between the claimed polycarbonate structure and the prior art teaches all the limitations as presently claimed, the rejection above is maintained.*

32. **Applicant's argument:** The applicant requests that the double patenting rejections be held in abeyance until allowable subject matter is indicated.

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***Examiner's response:*** *Applicant's request for abeyance is acknowledged to the extent that applicant's lack of response to the cited rejection will not be treated as non-responsive. However, since the rejection is proper it will be maintained until such time as a proper response to it is filed or conditions appropriate for removal of the rejection are present.*

### **Conclusion**

33. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Doris L. Lee whose telephone number is (571)270-3872. The examiner can normally be reached on Monday - Thursday 7:30 am to 5 pm and every other Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on (571)272-1119. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Doris L Lee/  
Examiner, Art Unit 1796

/Vasu Jagannathan/  
Supervisory Patent Examiner, Art Unit 1796